## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sarat C. Sankaran et al.    Examiner:  Virpi H. Kanervo

Serial No.: 09/804,851                            Group Art Unit:  3691

Filed: March 13, 2001                             Docket:  1285.013US1

For: INTERACTIVE METHOD AND APPARATUS FOR REAL-TIME FINANCIAL PLANNING

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## APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on September 30, 2009, from the Final Rejection of claims 21-35 and 38-42 of the above-identified application, as set forth in the Final Office Action mailed on July 15, 2009.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $540.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2).  Appellant respectfully requests consideration and reversal of the Examiner's rejections of pending claims.

## APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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## 1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, LAWSON SOFTWARE, INC.

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## 2.  RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in an appeal of this matter.

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## 3. STATUS OF THE CLAIMS

The present application was filed on March 13, 2001 with claims 1-20. A preliminary amendment was filed February 4, 2002 canceling claims 1-20 and adding claims 21-40.

A non-final Office Action was mailed on November 30, 2005 rejecting claims 21-40. A Final Office Action was mailed on May 18, 2006 rejecting claims 21-40. A Notice of Appeal was filed on October 17, 2006 with a related Appeal Brief filed on December 18, 2006.

Prosecution was reopened in a Restriction Requirement, which was mailed on April 20, 2007. The Restriction Requirement restricted claims 20-35, and 38-40 in Group I and claims 36 and 37 in Group II. Appellant elected Group I without traverse in a response filed May 11, 2007.

A non-final Office Action was mailed on August 15, 2007 rejecting claims 21-35 and 38-40. In the response to the non-final Office Action of August 15, 2007, claim 41 was added. A Final Office Action was mailed on March 24, 2008 rejecting claims 21-35 and 38-41. A Request for Continued Examination was filed on August 18, 2008.

A non-final Office Action was mailed on November 17, 2008 rejecting claims 21-35 and 38-41. In the response to the non-final Office Action of November 17, 2008 claim 42 was added. A Final Office Action was mailed on July 1, 2009 rejecting claims 21-35 and 38-42.

Claims 21-34 and 42 are canceled in the amendment and response filed with present Appeal Brief pursuant to CFR § 41.33(b)(1).

Claims 35 and 38-41 stand finally rejected and their rejection is the subject of the appeal of this matter.

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## 4. STATUS OF AMENDMENTS

Claims 35 and 38-41 have not been amended subsequent to the Final Office Action of July 1, 2009. Claims 21-34 and 42 have been canceled in the amendment filed with this Appeal Brief.

## 5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, methods and systems for real-time financial planning.

### INDEPENDENT CLAIM 35

35.     A computer-implemented method for controlling spending in a business that includes a plurality of departments, the method comprising the computer-implemented steps of:

receiving first data input that specifies a spending capacity for a department from the plurality of departments;[1]

in response to receiving the first data input, creating and storing first data in a public area, wherein the first data defines the spending capacity for the department, and wherein the public area is accessible by every user in the plurality of departments;[2]

receiving second data input that specifies one or more planned expenses for the department;[3]

in response to receiving the second data input, creating and storing second data in a private area, wherein the second data defines the one or more planned expenses based on the second data input, and wherein the private area is only accessible by users in the department, and wherein the private area is separate from the public area;[4]

automatically determining whether the second data is greater than the first data;[5]

when the second data is greater than the first data,

rejecting the planned expenses related to the second data;[6] and

transmitting a notification that the planned expenses have been rejected;[7] and

when the second data is not greater than the first data, storing the second data in the public area;[8]

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[1] *See, e.g.,* Application at page 9, lines 8-9; FIG. 8 at 1 and 2.
[2] *See, e.g., id.* at page 9, lines 10-12; FIG. 8 at 3.
[3] *See, e.g., id.* at page 9, lines 4-7; FIG. 8 at 5.
[4] *See, e.g., id.*
[5] *See, e.g., id.* at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.
[6] *See, e.g., id.* at page 16, lines 13-18; page 19, lines 26-30; FIG. 8 at 6.
[7] *See, e.g., id.*

receiving third data input that specifies a new spending capacity for the department from

the plurality of departments;[9]

in response to receiving the third data input, creating and storing third data in the public

area, wherein the third data defines the new spending capacity for the department;[10]

receiving fourth data input that specifies one or more planned expenses for the

department;[11]

in response to receiving the fourth data input, creating and storing fourth data in the

private area, wherein the fourth data defines the one or more planned expenses based on the

fourth data input;[12]

automatically determining whether the fourth data is greater than the third data;[13]

when the fourth data is greater than the third data,

rejecting the planned expenses related to the fourth data;[14] and

transmitting a notification that the new planned expenses have been rejected;[15]

and

when the fourth data is not greater than the third data, replacing the second data with the

fourth data in the public area,[16]

wherein each private area is comprised of one or more computer memory locations

assigned to each respective department, and wherein the public area is comprised of one or more

computer memory locations assigned to the plurality of departments.[17]

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[9] *See, e.g., id.* at page 9, lines 10-12; FIG. 3 at 210.
[9] *See, e.g., id.* at page 16, lines 13-25; page 9, lines 12-13.
[10] *See, e.g., id.* at page 16, lines 3-8; FIG. 8 at 3.
[11] *See, e.g., id.* at page 9, lines 4-7; FIG. 8 at 5.
[12] *See, e.g., id.* at page 9, lines 4-7 and lines 20-28; page 16, lines 22-24.
[13] *See, e.g., id.* at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.
[14] *See, e.g., id.* at page 16, lines 13-18; page 19, lines 26-30; FIG. 8 at 6.
[15] *See, e.g., id.*
[16] *See, e.g., id.* at page 9, lines 10-12; FIG. 3 at 210.
[17] *See, e.g., id.* at FIGS. 2, 4 and 9; page 8, lines 1-25.

## INDEPENDENT CLAIM 38

38.     A computer-readable medium carrying one or more sequences of instructions for financial planning by managing stored data values representing spending resources of an organization, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform the steps of:[18]

receiving first data input that specifies a spending capacity for at least a portion of the organization;[19]

in response to receiving the first data input, creating and storing spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input, and wherein the public area is accessible by every member of the organization;[20]

receiving second data input that specifies one or more planned expense allocations for the portion of the organization;[21]

in response to receiving the second data input, creating and storing planned expense data in a private area, wherein the planned expense data defines the one or more planned expense allocations based on the second data input, and wherein the private area is only accessible by members of the portion of the organization, and wherein the private area is separate from the public area;[22]

automatically determining whether the planned expense data exceeds the spending capacity data;[23]

storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data, otherwise, transmitting a notification that the planned expense data exceeds the spending capacity data;[24]

receiving third data input that specifies a new spending capacity for the portion of the organization;[25]

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[18] *See, e.g., id.* at page 8, lines 5-17; FIG. 2.
[19] *See, e.g., id.* at page 9, lines 8-9; FIG. 8 at 1 and 2.
[20] *See, e.g., id.* at page 9, lines 10-12; FIG. 8 at 3.
[21] *See, e.g., id.* at page 9, lines 4-7; FIG. 8 at 5.
[22] *See, e.g., id.*
[23] *See, e.g., id.* at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.
[24] *See, e.g., id.* at page 9, lines 10-12; page 16, lines 13-18; page 19, lines 26-30; FIG. 3 at 210; FIG. 8 at 6.
[25] *See, e.g., id.* at page 16, lines 13-25; page 9, lines 12-13.

in response to receiving the third data input, creating and storing new spending capacity data in the public area, wherein the new spending capacity data defines the new spending capacity based on the third data input;[26]

receiving fourth data input that specifies one or more new planned expense allocations for the portion of the organization;[27]

in response to receiving the fourth data input, creating and storing new planned expense data in the private area, wherein the new planned expense data defines the one or more planned expense allocations based on the fourth data input, and wherein the new planned expense data represents a revised version of the one or more planned expense allocations based on the second data input;[28]

automatically determining whether the new planned expense data exceeds the new spending capacity data;[29] and

replacing the planned expense data in the public area with the new planned expense data only when the new planned expense data does not exceed the new spending capacity data, otherwise, transmitting a notification that the new planned expense data exceeds the new spending capacity data.[30]

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[26] See, e.g., id. at page 16, lines 3-8; FIG. 8 at 3.
[27] See, e.g., id. at page 9, lines 4-7; FIG. 8 at 5.
[28] See, e.g., id. at page 9, lines 4-7 and lines 20-28; page 16, lines 22-24.
[29] See, e.g., id. at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.
[30] See, e.g., id. at page 9, lines 10-12; page 16, lines 13-18; page 19, lines 26-30; FIG. 3 at 210; FIG. 8 at 6.

## INDEPENDENT CLAIM 39

39.     A computer-automated apparatus for financial planning that manages stored data values representing spending resources of an organization, comprising:

means for receiving first data input that specifies a spending capacity for at least a portion of the organization;[31]

means for creating and storing, in response to receiving the first data input, spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input, and wherein the public area is accessible by every member of the organization;[32]

means for receiving second data input that specifies one or more planned expense allocations for the portion of the organization;[33]

means for creating and storing, in response to receiving the second data input, planned expense data in a private area, wherein the planned expense data defines the one or more planned expense allocations based on the second data input, and wherein the private area is only accessible by members of the portion of the organization, and wherein the private area is separate from the public area;[34]

means for automatically determining whether the planned expense data exceeds the spending capacity data;[35]

means for storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data, otherwise, means for transmitting a notification that the planned expense data exceeds the spending capacity data;[36]

means for receiving third data input that specifies a new spending capacity for the portion of the organization;[37]

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[31] See, e.g., id. at page 9, lines 8-9; FIG. 8 at 1 and 2.
[32] See, e.g., id. at page 9, lines 10-12; FIG. 8 at 3.
[33] See, e.g., id. at page 9, lines 4-7; FIG. 8 at 5.
[34] See, e.g., id.
[35] See, e.g., id. at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.
[36] See, e.g., id. at page 16, lines 13-18; page 19, lines 26-30; FIG. 8 at 6.
[37] See, e.g., id. at page 16, lines 3-12.

means for creating and storing, in response to receiving the third data input, new spending capacity data in the public area, wherein the new spending capacity data defines new the spending capacity based on the third data input;[38]

means for receiving fourth data input that specifies one or more new planned expense allocations for the portion of the organization;[39]

means for creating and storing, in response to receiving the fourth data input, new planned expense data in the private area, wherein the new planned expense data defines the one or more new planned expense allocations based on the fourth data input, and wherein the new planned expense data represents a revised version of the one or more planned expense allocations based on the second data input;[40]

means for automatically determining whether the new planned expense data exceeds the new spending capacity data;[41] and

means for replacing the planned expense data in the public area with the new planned expense data only when the new planned expense data does not exceed the new spending capacity data, otherwise, means for transmitting a notification that the new planned expense data exceeds the new spending capacity data,[42]

wherein each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization.[43]

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[38] *Id.*

[39] *See, e.g., id.* at page 16, lines 13-25; page 9, lines 12-13.

[40] *See, e.g., id.* at page 9, lines 4-7 and lines 20-28; page 16, lines 22-24; FIG. 8 at 5.

[41] *See, e.g., id.* at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.

[42] *See, e.g., id.* at page 16, lines 15-17; page 14, lines 22-23; page 19, lines 26-30.

[43] *See, e.g., id.* at FIGS. 2, 4 and 9; page 8, lines 1-25.

## INDEPENDENT CLAIM 40

40.     A computer-automated apparatus for financial planning that manages stored data values representing spending resources of an organization, comprising:

a network interface that is coupled to a data network for receiving one or more packet flows therefrom;[44]

a processor communicatively coupled to the network interface;[45]

one or more stored sequences of instructions which, when executed by the processor, cause the processor to carry out the steps of:[46]

receiving first data input that specifies a spending capacity for at least a portion of the organization;[47]

in response to receiving the first data input, creating and storing spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input, and wherein the public area is accessible by every member of the organization;[48]

receiving second data input that specifies one or more planned expense allocations for the portion of the organization;[49]

in response to receiving the second data input, creating and storing planned expense data in a private area, wherein the planned expense data defines the one or more planned expense allocations based on the second data input, and wherein the private area is only accessible by members of the portion of the organization, and wherein the private area is separate from the public area;[50]

automatically determining whether the planned expense data exceeds the spending capacity data;[51] and

storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data, otherwise, transmitting a

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[44] See, e.g., id. at page 7, lines 17-20 and 27-31; page 8, lines 5-17; FIG. 2.
[45] See, e.g., id. at page 8, lines 5-17; FIG. 2.
[46] See, e.g., id.
[47] See, e.g., id. at page 9, lines 8-9; FIG. 8 at 1 and 2.
[48] See, e.g., id. at page 9, lines 10-12; FIG. 8 at 3.
[49] See, e.g., id. at page 9, lines 4-7; FIG. 8 at 5.
[50] See, e.g., id.
[51] See, e.g., id. at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.

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notification that the planned expense data exceeds the spending capacity data;[52]

receiving third data input that specifies a new spending capacity for the portion of the organization;[53]

in response to receiving the third data input, creating and storing new spending capacity data in the public area, wherein the new spending capacity data defines the new spending capacity based on the third data input;[54]

receiving fourth data input that specifies one or more new planned expense allocations for the portion of the organization;[55]

in response to receiving the fourth data input, creating and storing new planned expense data in the private area, wherein the new planned expense data defines the one or more planned expense allocations based on the fourth data input, and wherein the new planned expense data represents a revised version of the one or more planned expense allocations based on the second data input;[56]

automatically determining whether the new planned expense data exceeds the new spending capacity data;[57] and

replacing the planned expense data in the public area with the new planned expense data only when the new planned expense data does not exceed the new spending capacity data, otherwise, transmitting a notification that the new planned expense data exceeds the new spending capacity data.[58]

This summary is presented in compliance with the requirements of 37 CFR § 41.37(c)(1)(V), mandating a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal ..." Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims or their equivalents in any way.

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[52] *See, e.g., id.* at page 9, lines 10-12; page 16, lines 13-18; page 19, lines 26-30; FIG. 3 at 210; FIG. 8 at 6.
[53] *See, e.g., id.* at page 16, lines 13-25, page 9, lines 12-13.
[54] *See, e.g., id.* at page 16, lines 3-8; FIG. 8 at 3.
[55] *See, e.g., id.* at page 9, lines 4-7; FIG. 8 at 5.
[56] *See, e.g., id.* at page 9, lines 4-7 and lines 20-28; page 16, lines 22-24.
[57] *See, e.g., id.* at page 9, lines 4-6; page 16, lines 13-18; FIG. 8 at 6.
[58] *See, e.g., id.* at page 9, lines 10-12; page 16, lines 13-18; page 19, lines 26-30; FIG. 3 at 210; FIG. 8 at 6.

Therefore, the preceding summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers the Examiner to the claims listed above and their legal equivalents for a complete statement of the invention. Page and line numbers or other references to Appellant's specification are given are exemplary in nature and not intended to be an exhaustive listing of each and every location where the particular subject matter can be found in the application.

## 6.  GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I)      Claims 35 and 39 were rejected under 35 U.S.C. § 101.


II)     Claim 39 was rejected under 35 U.S.C. § 112, 2nd paragraph.


III)    Claims 35 and 38-42 were rejected under 35 U.S.C. § 103(a) over Lautzenheiser
        (6,351,734 B1) in view of Their (7,130,822 B1).

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## 7. ARGUMENT

### A) The Applicable Law

#### A.1.    Standard of Review

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent."[59]

#### A.2.    The Applicable Law under 35 U.S.C. §101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.[60] The useful, concrete and tangible result "inquiry is insufficient to determine whether a claim is patent-eligible under §101."[61] Instead, a "machine-or-transformation test" is the sole criterion for patent eligibility where a "claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing."[62]

#### A.3.    The Applicable Law under 35 U.S.C. §112

The inquiry during examination is patentability of the invention as Appellant regards it. If the claims do not particularly point out and distinctly claim that which Appellant regards as their invention, the appropriate action by the examiner is to reject the claims under 35 U.S.C. § 112, second paragraph. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). If a

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[59] *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)(citations omitted); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).
[60] 35 U.S.C. § 101.
[61] *In re Bilski*, 545 F.3d 943, 959.
[62] *Id.* at 954.

rejection is based on 35 U.S.C. § 112, second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984).

### A.4.    The Applicable Law under 35 U.S.C. §103

Obviousness requires that the Examiner meet his or her burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness.[63] As discussed by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence.[64] The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*[65]: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

In combining prior art references to construct a *prima facie* case, the Examiner must show some objective evidence in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant portions of the references.[66] However, the level of skill is generally that of the person who follows the conventional wisdom in the art.[67] An invention can be obvious even though the reason to combine prior art teachings is not found in a specific reference.[68] But the requirement of some reason to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, which notes that the reason must be supported by some evidence in the record.[69]

The *KSR* Court merely rejected a rigid application of any "teaching, suggestion, motivation" test; it recognized that a more flexible conception of the test is entirely consistent

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[63] *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988).
[64] *See also Princeton Biochemcals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005).
[65] 383 U.S. 1, 17 (1966).
[66] *In re Fine.*
[67] *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 U.S.P.Q. 293, 298 (Fed. Cir. 1985).
[68] *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443 (Fed. Cir. 1992).
[69] *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.2D 1430 (Fed. Cir. 2002).

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with the *Graham* analysis.[70] The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention.[71] References must be considered in their entirety, including parts that teach away from the claims.[72] The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.[73]

Notably, the *KSR* Court affirmed that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."[74] The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art.[75] Moreover, when a reference teaches away from a claimed invention, this fact highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art.[76] If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.[77] The CCPA has also noted that "[t]he court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings."[78] Thus, these principles have not been changed by the ruling in *KSR*.

## B)    *The References*

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[70] *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 USPQ.2d 1385 (2007).
[71] *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).
[72] *See* M.P.E.P. § 2141.02.
[73] *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.
[74] *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007).
[75] *In re Bond*, *910* F.2d 831,834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).
[76] *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990).
[77] *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).
[78] *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969).

**Lautzenheiser et al. (U.S. 6,351,734):** relates to a system and method for resource management and distribution with respect to product development.[79]

**Their et al. (U.S. 7,130,822):** relates to a budget planning system for budget planning within a large organization.[80]

## C)     *Discussion of the Rejections*

### *C.1.     The Rejections of Claims 35 and 39 under 35 U.S.C. § 101.*

*Concerning claim 35:*

The Final Office Action asserted "[a]s to claim 35, the claim language recites a process comprising the steps of receiving data, creating data, and storing data."[81]  For a process to be patent-eligible, the process must be "tied to a particular machine or apparatus."[82]  Appellant respectfully submits that claim 35 conforms to § 101.  In particular, claim 35 recites in part, "wherein each private area is comprised of one or more computer memory locations," and "wherein the public area is comprised of one or more computer memory locations."  Based on at least these portions of claim 35, Appellant submits that a computer is used, at least in part, to perform the operations of "creating and storing first data in a public area," "creating and storing second data in a private area," as claim 35 recites, along with other operations recited in claim 35 that access the public or private areas to create, store, or retrieve data.  Thus, Appellant respectfully submits that claim 35 properly recites statutory subject matter and requests reversal of the § 101 rejection of this claim.

*Concerning claim 39:*

The Final Office Action rejected claim 39 stating "[t]he 'means for' could be interpreted as either the server and network, or the software modules."[83]  The Final Office Action further

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[79] *See Lautzenheiser* at Abstract
[80] *See Their* at Abstract
[81] Final Office Action of June 30, 2009 at p. 7, § 11.
[82] *In re Bilski*, 545 F.3d 943, 954.
[83] Final Office Action of June 30, 2009 at p. 8, § 11.

stated "[s]ince the claimed invention could be interpreted as consisting entirely of software, the claim is not considered statutory, because software is not patentable subject matter."[84]

Appellant claims a "computer-automated apparatus."[85] In doing so, Appellant has created a context for the claim limitations and submits that the subsequent claim limitations be considered in light of the preamble. To that end, claim limitations that include functional aspects must be operable in the context of a "computer-automated apparatus." In particular, while claim limitations that describe functional operations may be implemented, at least in part, in software, Appellant respectfully submits that inferentially there must be at least some hardware. That is, if the claim's functional limitations were construed as completely excluding hardware, the claim's preamble reciting "a computer-automated apparatus" would be without meaning.

Moreover, Appellant respectfully directs attention to the claim limitation "wherein each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised of one or more computer memory locations assigned to the organization." Computer memory locations do not exist purely within software. Although software may create and maintain data structures and other mechanisms to address, allocate, and otherwise manage computer memory locations, the computer memory locations themselves are extant in hardware. Thus, to the extent that the functional limitations in claim 39 may be considered as software, Appellant respectfully submits that the functional operations represent structural and functional interrelationships between the purported computer program and the rest of the computer that permits the purported computer program's functionality to be realized.

Thus, Appellant respectfully submits that claim 39 properly recites statutory subject matter and requests reversal of the § 101 rejection of this claim.

### *C.2.     The Rejection of Claim 39 under 35 U.S.C. § 112.*

*Concerning claim 39:*

Claim 39 was rejected under 35 U.S.C. § 112 in the Final Office Action, which stated:

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[84] *Id.*
[85] Claim 39 at Preamble.

It is unclear whether the means for refer to the software or the hardware described in the specification. See the rejection under 35 U.S.C. § 101, below.[86]

Appellant respectfully submits that this is an improper § 112 rejection. In particular, to the extent that the rejection should be made under § 101, Appellant refers the Board to the previous section C.1., *supra*.

As to the Examiner's assertion that "it is unclear whether the means for refer to the software or hardware," Appellant respectfully submits that all means of performing the recited operations are encompassed by these claims. Appellant respectfully submits that breadth is not indefiniteness.[87] The actual mechanism or mechanisms used are purposefully recited in general terms to provide broader scope. Appellant respectfully submits that one of ordinary skill in the art would understand that the "means for receiving," and "means for creating and storing," along with other means could be carried out in various implementations that may include software, hardware, or combinations thereof. Thus, Appellant respectfully requests reconsideration and reversal of the § 112 rejection of claim 39.

### *C.3.     The Rejections of Claims 35 and 38-42 using Lautzenheiser in view of Their.*

*Concerning claim 35:*

Appellant cannot find in the cited portions of Lautzenheiser or Their any disclosure of "wherein the private area is only accessible by users in the department," as claim 35 recites. As acknowledged by the Final Office Action at page 10, "Lautzenheiser fails to teach initially storing the planned expense data in a private area, and storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data." The Final Office Action relies upon Their as assertedly "teach[ing] storing planned expense data in a private area (Their: col. 6, lines 41-47), and storing the planned expense data in the public area when the planned expense is approved (Their: col. 5, line 62 – col. 6, line 5)."[88]

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[86] Final Office Action of June 30, 2009 at p. 7, § 9.
[87] See MPEP § 2173.04.
[88] Final Office Action of June 30, 2009 at p. 10-11.

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However, a closer review of Their reveals that the Final Office Action's position is unfounded. The Final Office Action cites to column 6, lines 41-47 of Their. This portion of Their is reproduced herein.

> The hierarchy represents the workflow of the corporation and, therefore, is intuitive to the contributors. Furthermore, each contributor has a limited view such that left frame **65** only displays the part of the hierarchal model **38** that relates to the particular contributor. *Because Guy is a high-level executive defined as a reviewer for all five regions, he can view the entire hierarchy.*

(emphasis added). As is clearly stated in the cited portion of Their, while a contributor may have limited view into the hierarchy, a high-level executive (e.g., Guy) can view *the entire hierarchy*. Plainly, the contributor's portion of the hierarchy is not a "private area is only accessible by users in the department," as claim 35 requires. "Guy, the CFO" would not be considered a user in the department of the contributor in the example, e.g., "Andy for Outlet A."[89] If "Guy" were to be assigned to any department, it may be one such as "Executives" or "Corporate Management" or the like. What ever the case, Their's example of "Guy" is clearly deficient to teach or disclose "wherein the private area is only accessible by users in the department," as claim 35 recites.

Restated, review of other portions of Their, including the text associated with figure 4, do not describe, teach or suggest using separate areas for private and public planning. In fact, reviewing figures 6 and 12 of Their would suggest otherwise. Figure 6 is an illustration of a top-level user who is apparently able to view budget plans of children nodes that have statuses of "Not Started," and "Work in Progress."[90] There is no discussion in Their that the top-level user, in this example "Guy, the CFO" is prohibited from viewing the budgetary planning of the owners of the child nodes. Therefore, the obvious capability represented in the figure is not countered.

Appellant respectfully submits that because Lautzenheiser and/or Their fail to disclose, teach, or suggest the use of both a private and public planning areas, that Lautzenheiser and/or Their, alone or in combination, do not anticipate or render obvious the claimed subject matter.

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[89] *See* Their at FIG. 4 and associated text.
[90] Their at FIG. 6.

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Thus, Appellant respectfully requests reconsideration and reversal of the § 103 rejection of claim 35.

*Concerning claim 38:*

Claim 38 recites in part, "wherein the private area is only accessible by members of the portion of the organization." As discussed above with respect to claim 35, Appellant respectfully submits that neither Lautzenheiser nor Their disclose such a limitation. In this case, Appellant respectfully submits that "Guy," as provided by way of examiner in Their, is not a "member of the portion of the organization,"[91] as the contributor, e.g., "Andy." Thus, Appellant respectfully requests reconsideration and reversal of the § 103 rejection of claim 38.

*Concerning claim 39:*

Claim 39 recites in part, "wherein the private area is only accessible by members of the portion of the organization." As generally discussed above with respect to claim 35, and specifically discussed above with respect to claim 38, Appellant respectfully submits that neither Lautzenheiser nor Their disclose such a limitation. Thus, Appellant respectfully requests reconsideration and reversal of the § 103 rejection of claim 39.

*Concerning claim 40:*

Claim 40 recites in part, "wherein the private area is only accessible by members of the portion of the organization." As generally discussed above with respect to claim 35, and specifically discussed above with respect to claim 38, Appellant respectfully submits that neither Lautzenheiser nor Their disclose such a limitation. Thus, Appellant respectfully requests reconsideration and reversal of the § 103 rejection of claim 40.

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[91] As claim 35 recites.

## SUMMARY

In sum, because the cited references do not disclose, teach, or suggest all of the subject matter of claims 35 and 38-41, Appellant respectfully requests reconsideration and withdrawal of all bases of rejection of all claims. Furthermore, any dependent claims not specifically addressed depend directly or indirectly on independent claim 35 and accordingly incorporate the limitations of this independent claim. As such, Appellant respectfully requests reconsideration and withdrawal of all bases of rejection of all dependent claims.

Respectfully submitted,

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Date ___30 Dec 2009___          By ___/_____/___

John I. Fischer
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this _30_ day of December 2009.

Nicole Jack
_____
Name                                         Signature

## 8.  CLAIMS APPENDIX

35.      A computer-implemented method for controlling spending in a business that includes a

plurality of departments, the method comprising the computer-implemented steps of:

      receiving first data input that specifies a spending capacity for a department from the

plurality of departments;

      in response to receiving the first data input, creating and storing first data in a public area,

wherein the first data defines the spending capacity for the department, and wherein the public

area is accessible by every user in the plurality of departments;

      receiving second data input that specifies one or more planned expenses for the

department;

      in response to receiving the second data input, creating and storing second data in a

private area, wherein the second data defines the one or more planned expenses based on the

second data input, and wherein the private area is only accessible by users in the department, and

wherein the private area is separate from the public area;

      automatically determining whether the second data is greater than the first data;

      when the second data is greater than the first data,

            rejecting the planned expenses related to the second data; and

            transmitting a notification that the planned expenses have been rejected; and

      when the second data is not greater than the first data, storing the second data in the

public area;

      receiving third data input that specifies a new spending capacity for the department from

the plurality of departments;

      in response to receiving the third data input, creating and storing third data in the public

area, wherein the third data defines the new spending capacity for the department;

      receiving fourth data input that specifies one or more planned expenses for the

department;

      in response to receiving the fourth data input, creating and storing fourth data in the

private area, wherein the fourth data defines the one or more planned expenses based on the

fourth data input;

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automatically determining whether the fourth data is greater than the third data;

when the fourth data is greater than the third data,

rejecting the planned expenses related to the fourth data; and

transmitting a notification that the new planned expenses have been rejected; and

when the fourth data is not greater than the third data, replacing the second data with the fourth data in the public area,

wherein each private area is comprised of one or more computer memory locations assigned to each respective department, and wherein the public area is comprised of one or more computer memory locations assigned to the plurality of departments.

38.     A computer-readable medium carrying one or more sequences of instructions for financial planning by managing stored data values representing spending resources of an organization, wherein execution of the one or more sequences of instructions by one or more processors causes the one or more processors to perform the steps of:

receiving first data input that specifies a spending capacity for at least a portion of the organization;

in response to receiving the first data input, creating and storing spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input, and wherein the public area is accessible by every member of the organization;

receiving second data input that specifies one or more planned expense allocations for the portion of the organization;

in response to receiving the second data input, creating and storing planned expense data in a private area, wherein the planned expense data defines the one or more planned expense allocations based on the second data input, and wherein the private area is only accessible by members of the portion of the organization, and wherein the private area is separate from the public area;

automatically determining whether the planned expense data exceeds the spending capacity data;

storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data, otherwise, transmitting a notification that the

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planned expense data exceeds the spending capacity data;

receiving third data input that specifies a new spending capacity for the portion of the organization;

in response to receiving the third data input, creating and storing new spending capacity data in the public area, wherein the new spending capacity data defines the new spending capacity based on the third data input;

receiving fourth data input that specifies one or more new planned expense allocations for the portion of the organization;

in response to receiving the fourth data input, creating and storing new planned expense data in the private area, wherein the new planned expense data defines the one or more planned expense allocations based on the fourth data input, and wherein the new planned expense data represents a revised version of the one or more planned expense allocations based on the second data input;

automatically determining whether the new planned expense data exceeds the new spending capacity data; and

replacing the planned expense data in the public area with the new planned expense data only when the new planned expense data does not exceed the new spending capacity data, otherwise, transmitting a notification that the new planned expense data exceeds the new spending capacity data.

39.     A computer-automated apparatus for financial planning that manages stored data values representing spending resources of an organization, comprising:

means for receiving first data input that specifies a spending capacity for at least a portion of the organization;

means for creating and storing, in response to receiving the first data input, spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input, and wherein the public area is accessible by every member of the organization;

means for receiving second data input that specifies one or more planned expense allocations for the portion of the organization;

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means for creating and storing, in response to receiving the second data input, planned expense data in a private area, wherein the planned expense data defines the one or more planned expense allocations based on the second data input, and wherein the private area is only accessible by members of the portion of the organization, and wherein the private area is separate from the public area;

means for automatically determining whether the planned expense data exceeds the spending capacity data;

means for storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data, otherwise, means for transmitting a notification that the planned expense data exceeds the spending capacity data;

means for receiving third data input that specifies a new spending capacity for the portion of the organization;

means for creating and storing, in response to receiving the third data input, new spending capacity data in the public area, wherein the new spending capacity data defines new the spending capacity based on the third data input;

means for receiving fourth data input that specifies one or more new planned expense allocations for the portion of the organization;

means for creating and storing, in response to receiving the fourth data input, new planned expense data in the private area, wherein the new planned expense data defines the one or more new planned expense allocations based on the fourth data input, and wherein the new planned expense data represents a revised version of the one or more planned expense allocations based on the second data input;

means for automatically determining whether the new planned expense data exceeds the new spending capacity data; and

means for replacing the planned expense data in the public area with the new planned expense data only when the new planned expense data does not exceed the new spending capacity data, otherwise, means for transmitting a notification that the new planned expense data exceeds the new spending capacity data,

wherein each private area is comprised of one or more computer memory locations assigned to each respective portion of the organization, and wherein the public area is comprised

of one or more computer memory locations assigned to the organization.

40.    A computer-automated apparatus for financial planning that manages stored data values representing spending resources of an organization, comprising:

a network interface that is coupled to a data network for receiving one or more packet flows therefrom;

a processor communicatively coupled to the network interface;

one or more stored sequences of instructions which, when executed by the processor, cause the processor to carry out the steps of:

receiving first data input that specifies a spending capacity for at least a portion of the organization;

in response to receiving the first data input, creating and storing spending capacity data in a public area, wherein the spending capacity data defines the spending capacity based on the first data input, and wherein the public area is accessible by every member of the organization;

receiving second data input that specifies one or more planned expense allocations for the portion of the organization;

in response to receiving the second data input, creating and storing planned expense data in a private area, wherein the planned expense data defines the one or more planned expense allocations based on the second data input, and wherein the private area is only accessible by members of the portion of the organization, and wherein the private area is separate from the public area;

automatically determining whether the planned expense data exceeds the spending capacity data; and

storing the planned expense data in the public area only when the planned expense data does not exceed the spending capacity data, otherwise, transmitting a notification that the planned expense data exceeds the spending capacity data;

receiving third data input that specifies a new spending capacity for the portion of the organization;

in response to receiving the third data input, creating and storing new spending capacity data in the public area, wherein the new spending capacity data defines the new spending capacity based on the third data input;

receiving fourth data input that specifies one or more new planned expense allocations for the portion of the organization;

in response to receiving the fourth data input, creating and storing new planned expense data in the private area, wherein the new planned expense data defines the one or more planned expense allocations based on the fourth data input, and wherein the new planned expense data represents a revised version of the one or more planned expense allocations based on the second data input;

automatically determining whether the new planned expense data exceeds the new spending capacity data; and

replacing the planned expense data in the public area with the new planned expense data only when the new planned expense data does not exceed the new spending capacity data, otherwise, transmitting a notification that the new planned expense data exceeds the new spending capacity data.

41.    A method as recited in Claim 35, further comprising the computer-implemented steps of:

when the second data input is greater than the first data input, receiving a request to increase the spending capacity for the department;

determining whether the request is allowable; and

when the request is allowable, updating the spending capacity for the department.

# 9.  EVIDENCE APPENDIX

None.

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## 10.  RELATED PROCEEDINGS APPENDIX

None.